

## REMARKS

### The Amendments

New claim 25 combines the subject matter of original claim 1 and previous claim 11. Claims 26-33 are identical to previous claims 2-3, 7-10 and 12 except they are dependent on claim 25 and typographical errors in formula (2) are corrected. New claims 34-45 are identical to claims 13-24 indicated to be allowable. They are re-submitted as new claims because there previously was confusion on the claim numbering and also to correct typographical errors in formula (2).

The amendments should not be interpreted as an acquiescence to any objection or rejection made in this application but are made only to clarify the invention and/or expedite the prosecution of this application. To the extent that the amendments avoid the prior art, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

### The Rejection under 35 U.S.C. §103

The rejection of claims 1-3 and 7-12 under 35 U.S.C. §103 as being obvious over Tarumi et al. (U.S. Patent No. 5,837,774) in view of Stoetzer (U.S. Patent No. 4,518,524) is respectfully traversed.

Pursuant to a telephone discussion with Examiner Rajguru on January 5, 2000, it is believed that the above amendment, which results in the subject matter of previous claim 11 now being incorporated into the rejected independent claim, will put the application in condition for allowance.

Neither of the cited references provide any teaching regarding the use of silver particles restricted as to  $\text{NH}_4^+$  or  $\text{SO}_4^{2-}$  content. Although, for the following reasons, applicants remain of the opinion that one of ordinary skill in the art would not have modified Tarumi to include silver particles at all, such person of ordinary skill would certainly not have modified Tarumi to include such specific type of silver particles.

Applicants also maintain their previous position that the prior art fails to motivate one of ordinary skill in the art to make the Tarumi compositions conductive. Although, as stated in the Office Action, if one "wants to render the composition of Tarumi conductive, one would surely incorporate conductive (metallic) particles into that composition," the art must suggest that one would "want" to do so.

Contrary to suggesting the inclusion of silver or other conductive particles in its compositions, Tarumi discusses possible additives to its compositions at col. 9, lines 18-42, none of which include silver particles or similar conductive materials.

Further, no teaching in Stoetzer suggests that the Tarumi compositions should be modified. There is no suggestion from Stoetzer of a desirability to use a hydrosilylation curable composition, such as disclosed by Tarumi, as the binder resin for its coatings. To the contrary, Stoetzer provides a clear suggestion to use other types of binder resin materials, such as polyesters.

In order to establish obviousness under 35 U.S.C. §103, the mere fact that the prior art could be modified to arrive at the claimed invention is insufficient. The prior art must suggest to one of ordinary skill in the art the desirability of the necessary modification. See In re Laskowski, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989); and, In re Geiger, 2 U.S.P.Q.2d 1276 (Fed. Cir. 1987). It is respectfully submitted, for the reasons given above, that the prior art of record fails to suggest the desirability of combining the references in the manner necessary to arrive at the claimed invention and, thus, the prior art as a whole fails to establish obviousness of the claimed invention.

The distinct utilities of the materials which are the subject of the two reference inventions also directs one of ordinary skill in the art away from combining the teachings thereof. Tarumi provides no suggestion of any application requiring the conductive properties resulting in Stoetzer. Further, neither reference discloses use of its materials for the particular applications of the instant invention, i.e., die bonding of semiconductor devices and mounting of quartz crystal oscillators. These factors are further indicative of the failure of the prior art to teach or suggest the combination of applicants' invention.

For all of the above reasons, it is respectfully submitted that the prior art considered as a whole fails to render the claimed invention obvious to one of ordinary skill in the art since there is no suggestion to motivation to combine the reference teachings in a manner suggestive

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of applicants' invention. Accordingly, the rejection under 35 U.S.C. §103 should be withdrawn.

It is submitted that the claims are in condition for allowance and early notification thereof is earnestly solicited. If issues remain unresolved, the examiner is kindly invited to contact the undersigned by telephone to discuss matters which may further the prosecution of this application or facilitate the allowability of some or all of the claims herein.

Respectfully submitted,

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